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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/081,465	02/22/2002	Edward Robert Perry	PERRY-010	1060
7590	12/04/2003		EXAMINER	
John B. Sowell 182 Midfield Road Ardmore, PA 19003-3213			PRONE, JASON D	
			ART UNIT	PAPER NUMBER
			3724	
			DATE MAILED: 12/04/2003	

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application N .</b>	<b>Applicant(s)</b>
	10/081,465	PERRY, EDWARD ROBERT
	<b>Examiner</b>	<b>Art Unit</b>
	Jason Prone	3724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 07 September 2003.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 9-16 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-8 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 22 February 2002 is/are: a) accepted or b) objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. §§ 119 and 120

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) The translation of the foreign language provisional application has been received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

#### Attachment(s)

- |  |  |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                               | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)           | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . | 6) <input type="checkbox"/> Other: _____ .                                   |

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The information disclosure statement filed 29 July 2002 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. The patents listed on the I.D.S. refer to hearing aids and not to any type of cutting device. It has been placed in the application file, but the information referred to therein has not been considered.

### ***Election/Restrictions***

2. Applicant's election with traverse of Group I in Paper No. 4 is acknowledged.

3. Claims 9-16 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made with traverse in Paper No. 4.

### ***Drawings***

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: In Figure 1, item "θ". In Figure 8, item "TK". In Figure 12, item "48". In Figure 16, items "57", "60", "61", and "62". A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

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5. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "11" has been used to designate both grooves, on page 8 line 3, and a hub, on page 10 line 23, reference character "23" has been used to designate both a cutting wheel, on page 9 line 8, and a disc base member, on page 9 line 10, reference character "24" has been used to designate both a supporting disc, on page 9 line 9, and a center, on page 9 line 10, reference character "27" has been used to designate both diamonds, on page 9 line 19, and particles, on page 9 line 24, reference character "37" has been used to designate both a tip, on page 12 line 23, an annular ring, on page 12 line 26, an annular corrugated singulation blade, on page 13 line 4, and corrugated rings on page 13 line 10, reference character "38" has been used to designate both a shoulder, on page 13 line 2, and a shelf, on page 13 line 7. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

6. The drawings are objected to because it is unclear how Figures 7-14 relate to one another. It is unclear, if the blade in Figure 7 is the same blade in Figure 9 and if they are the same blade in Figure 11, because they do not share any common reference labels. Another example is it is uncertain if Figure 10 is a side view of Figure 8. It is unclear how the drill pipe, in Figure 12, is attached or where it is attached and to which blade it is attached. It is not clear what view Figures 13 and 14 represent. It is assumed that item "44" is the transition portion, also shown in Figure 8, when comparing Figure 8 to Figures 13 and 14, it is concluded that the diamonds "49" would

not be on the edge (shown in Figure 8) but corner portions of the matrix ring going into the paper, therefore, it is unclear how the diamonds would be used to cut. Comparing Figures 4 and 5, it is unclear what item "25" is pointing at. In Figure 4 "25" is pointing at the cutting edge mass but in Figure 5, "25" is pointing to an area. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

7. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the diamonds that are encapsulated, a serpentine matrix shape, an endless flexible ribbon, an adapter portion for connecting the saw blade to the flexible blade, an adapter portion for connecting the singulation blade to the drill rod or pipe, and an inundating shaped blade must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

#### ***Specification***

8. The disclosure is objected to because of the following informalities: On page 15 lines 13-14, with reference to Figure 11, the phrase "raised surfaces 42 and 120 lowered surfaces 43" Should be replaced with "lowered surfaces 42 and 120 raised surfaces 43". On page 17 line 4, the phrase "Figure 12 and Figure 13" should be replaced with "Figure 13 and Figure 14".

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

9. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

10. Claims 1-8 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. It is unclear how the diamonds are encapsulated inside the matrix when they are clearly on the surface shown in Figures 13 and 14. When comparing Figure 8 to Figures 13 and 14, it is concluded that the diamonds "49" would not be on the edge (shown in Figure 8) but corner portions of the matrix ring going into the paper, therefore, it is unclear how the diamonds would be used to cut and where the cutting surface actually is. It is unclear from the specification and the Figures what the endless flexible ribbon and what the adaptor portion for connecting the endless flexible ribbon to the saw blade are. It is clear from the specification what the drill pipe (Figure 12) is, however, it is unclear from the specification and the Figures what a drill rod, pipe, and the adaptor portion for connecting the blade to the drill rod or pipe are.

11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12. Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

13. In regards to claims 1 and 8, it is unclear how the diamonds are encapsulated in the matrix walls. If the diamonds were encapsulated they would be surrounded or inside the wall, therefore, preventing any contact with the work piece.

14. Claim 3 recites the limitations "the cutting area" and "the total thin wall transition area". There is insufficient antecedent basis for these limitations in the claim.

15. In regards to claim 4, the phrase "the saw blade becomes concave at the cutting edge and the center of the blade becomes recessed between two parallel cutting side walls" is unclear. First, with reference to Figure 11, it is uncertain if the concave portions (42) is the cutting edge and the convex portions (43) are dull and do not cut. Second, it is not certain if the side walls are the cutting surface.

16. In regards to claim 6, it is not clear what the endless flexible ribbon is or what its adaptor portion is.

17. In regards to claim 7, it is not clear what the adaptor portion for the drill rod or pipe is.

18. It is to be noted that claims 1-8 have not been rejected over prior art. It may or may not be readable over the prior art but cannot be determined at this time in view of the issues under 35 USC § 112.

***Conclusion***

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19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Rue, Levinson et al., and Ishizuka. *Cited in specification by applicant*  
JP 12-3-03
20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason Prone whose telephone number is 703-605-4287.

The examiner can normally be reached on 7:30-5:00, Mon - (every other) Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan N. Shoap can be reached on 703-308-1082. In lieu of mailing, it is encouraged that all formal responses be faxed to 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

JP  
December 2, 2003

*alln*  
Allan N. Shoap  
Supervisory Patent Examiner  
Group 3700